

Appl. No. 10/655,921
Amdt. Dated January 26, 2005
Reply to Office Action dated October 28, 2004

REMARKS

In the non-final Office Action, the U.S. Patent Examiner has indicated that Claim Nos. 1 – 37 are pending in the application. Claim Nos. 1 – 28 are allowed; Claim Nos. 29 – 32, and 36 are rejected; and Claim Nos. 33 – 35, and 37 are objected to. The U.S. Patent Examiner has made no statement concerning either the Specification or the drawings. In response to the Office Action, applicants have made a number of amendments, including a number of newly drafted claims. Accordingly, newly drafted Claim Nos. 71 – 75 now appear in the application. The Honorable Commissioner for Patents is authorized to Charge Deposit Account No. 502063 for any claim fees that may be now due.

In the Office Action, the U.S. Patent Examiner has indicated that Claim No. 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph as set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims. Accordingly, Applicants submit herewith newly drafted independent Claim No. 71, which claim incorporates the subject matter found in rejected independent Claim No. 29 and rejected dependent Claim No. 31. The U.S. Patent Examiner has further indicated that Claim Nos. 33, 34, 35, and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Applicants submit herewith newly drafted Claim Nos. 72 – 75. Newly drafted independent Claim No. 72 comprises the subject matter found in

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rejected independent Claim No. 29, rejected dependent Claim No. 32, and objected to dependent Claim No. 33. Newly drafted dependent Claim No. 73 comprises the subject matter found in objected to dependent Claim No. 34 and newly drafted dependent Claim No. 74 comprises the subject matter found in objected to dependent Claim No. 35. Newly drafted independent Claim No. 75 comprises the subject matter found in rejected independent Claim No. 29 and objected to dependent Claim No. 37.

In the Office Action, the U.S. Patent Examiner has further stated that independent Claim No. 29 and dependent Claim Nos. 32, and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Design Patent No. D352,480, which issued to Carlson ('480 Patent). In response to the rejection of independent Claim No. 29 under 35 U.S.C. § 102(b), Applicants submit the following remarks.

In *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), the Federal Circuit Court stated that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ at 313 (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), adopted, 149 USPQ 640 (Ct. Cl. 1966)). It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as further stated by the Federal Circuit Court, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)(emphasis added). The Federal Circuit

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Court has indicated that “[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ at 485.

Further, “[u]nder 35 U.S.C. 102, anticipation requires that ... the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public.” *Akzo N.V. v. U.S. Int’l Trade Comm’n*, 808 F.2d 1471, 1 USPQ 2D 1241, 1245 (Fed. Cir. 1986)(citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (C.C.P.A. 1964)). The Federal Circuit Court has added that the anticipation determination is viewed from one of ordinary skill in the art: “There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

By combining the elements of the various decisions, a prima facie case of anticipation is established when a U.S. Patent Examiner provides:

- 1) a single reference
- 2) that teaches or enables
- 3) each of the claimed elements (arranged as in the claim)
- 4) expressly or inherently
- 5) as interpreted by one of ordinary skill in the art.

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An applicant who is able to prove that any one of these elements is not present will effectively prevent the prima facie case of anticipation from being established.

With regard to the Element No. 1, namely, "a single reference," Applicants concede that this element has been met by the U.S. Patent Examiner. Claim Nos. 29, 32, and 36 have all been rejected under 35 U.S.C. 102(b) as being anticipated by the '480 Patent – a single reference.

With regard to Element Nos. 2 – 5 of the prima facie case, however, Applicants generally take note of the '480 Patent in its entirety and have paid particular attention to a copy of Figure Nos. 7 and 8 as marked upon by the U.S. Patent Examiner, which marked-up copy is enclosed herewith and further marked as Exhibit A. The U.S. Patent Examiner has further made specific reference to Figure No. 2 (Page No. 3, Line No. 3 of the Office Action) with regard to certain limitations on the oversized planter container as mentioned in the preamble of Claim No. 29. In this regard, the U.S. Patent Examiner has stated, as follows:

"Regarding Claim 29, Carlson teaches a container insert for creating a false bottom in an oversized planter container comprising a container bottom, a container rim, and a substantially uniformly sloped inner container surface, the inner container surface extending from the container bottom to the container rim, the inner container surface having a select container periphery intermediate the container bottom and the container rim (Fig. 2); ..."

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The U.S. Patent Examiner has not supplied Applicants with a marked-up copy of Figure 2 and thus Applicants are confused as to how Figure No. 2 of the '480 Patent may be viewed as showing an anticipatory inner container surface having a select container periphery intermediate the container bottom and container rim. Clarification is kindly requested.

Further, it will be noted from the U.S. Patent Examiner's very own reproduction of language appearing in Claim No. 29, as detailed above, that the preamble quite clearly recites the term, 'oversized planter container.' Yet on Page No. 4, last line(s) on the page and extending to Page No. 5, the U.S. Patent Examiner has recommended that Applicants "...positively recite... 'oversized planter container' in the preamble to advance patentability of Claim No. 29 ...". Since the language 'oversized planter container' already appears in Claim No. 29 (as reproduced by the U.S. Patent Examiner), Applicants are confused as to the recommendations provided them by the U.S. Patent Examiner. Clarification is kindly requested.

In Figure No. 7 of Exhibit A, the U.S. Patent Examiner has provided certain nomenclature and lead lines with arrows as a means to identify certain structure. In this regard, the U.S. Patent Examiner has hand-written, "apertures," "superior surface," and "support rib." With Figure No. 8 in view, the U.S. Patent Examiner has hand-written, "peripheral support rim," "peripheral support surface," and "inferior surface." Applicants suppose that it is the U.S. Patent Examiner's opinion that Figure Nos. 7 and 8 of the '480 Patent "teach or enable each of the claimed elements (arranged as in Claim No. 29) expressly or inherently as interpreted by one of ordinary skill in the art." The "teach or enable" element (Element No. 2) contains two requirements for a reference to support an

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anticipation rejection; (1) the reference must disclose the claimed invention, and (2) it must be available to the public. Applicants note that the '480 Patent issued on November 15, 1994. Applicants filed the subject patent application on September 5, 2003. Applicants thus concede that the U.S. Patent Examiner has satisfied the second requirement for the "teach and enable" element. The '480 Patent was publicly available. However, Applicants further contend that the '480 Patent does not disclose the subject matter as claimed in Claim No. 29 and thus the first requirement of the "teach and enable" element has not been met. Additionally, it is Applicants' further contention that Element Nos. 3 – 5 of the prima facie case have also not been met for the reasons as outlined hereinafter.

In this last regard, it is noted that the '480 Patent is a design patent, and as such, protects the ornamental design for the so-entitled "planter," as shown. No descriptions of the so-entitled "planter," other than those brief figure descriptions on the cover page of the '480 Patent, appear in the patent. Thus, it is not readily apparent to Applicants that the structures, to which the U.S. Patent Examiner has assigned nomenclature, are indeed the type of structures that the U.S. Patent Examiner summarily states. Remarkably, in this regard, the so-called "support ribs" as described by the U.S. Patent Examiner, ornamentally appear to be frustoconically-shaped, hollow columns for supporting the so-called "plate" as it has been described in the brief figure descriptions on the cover page of the '480 Patent.

From a further inspection of Figure Nos. 2, 4, 5, 7, and 8 of the '480 Patent, it would ornamentally appear as though the so-called "support ribs" are hollow. Applicants maintain that the hollow column of the '480 Patent would require a significant amount of

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compressive strength in the materials used in the construction of the "plate" (the frustoconically-shaped, hollow columns apparently being formed integral with the planar portion of the plate) so as to more properly support the "plate" with additional load (as it is presumed the so-called "planter" functions to hold plants). Further, the circular junctions where the "support ribs" (i.e. columns) meet the horizontal portion of the "plate" would require a fair amount of junction strength so that the planar portions of the "plate" would remain substantially orthogonal to the longitudinal axes of the support columns ("support ribs") of the '480 Patent when appreciable loads are placed upon the planar portion(s).

Columns, it will be ordinarily understood, include pillars, poles, posts, piers, studs, shafts, mullions, uprights, colonettes, caryatides, and telamones; variations, include buttresses, corbels, impost, pilasters, and bearing walls. Notably columns provide excellent support structure for matter located in superior adjacency to the columns, posts, or legs. Columns, for example, typically support the substantially planar surfaces of tables, chairs, or stools. When a load is placed upon the planar (superior) surface of a stool, for example, the force acts to otherwise the columns and thus the columns must be able to withstand the compressive forces. And thus it is noted that columns do provide excellent support structure in appropriate structural scenarios. Presumably, Carlson included columns in the design of his "plate" and "planter" so that the columns could provide appropriate support to the "plate." However, it is further noted that the columns further function to occupy space in inferior adjacency to the "plate" and in superior adjacency to the bottom of the "pot" as will be seen from an inspection of Figure No. 5 of

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the '480 Patent. Presumably, Carlson intended that the so-called "support ribs" would function to occupy a certain amount of space intermediate the "plate" and "pot".

Notably, Applicants have made these presumptions because they have very little guidance from the U.S. Patent Examiner as to why structure that would otherwise appear to be columns would provide the same support structure as support ribs 24 (as illustrated in Figure Nos. 3 and 6 of the subject application). Support ribs 24 do not occupy space intermediate the peripheral support rim 27 (as referenced in Figure Nos. 1, 3, 5, 6, and 7) and container bottom 101 (as illustrated in Figure Nos. 1 and 3) of the subject application. The "support ribs" the U.S. Patent Examiner has described and support ribs 24, while both providing support structure, do not provide equivalent support structure, nor do the "support ribs" of the '480 provide anticipate support ribs 24. Together, superior support surface 21, inferior support surface 22, and support ribs 24 are akin to a ribbed slab (support ribs 24 being preferably integrally formed with inferior support surface 22), which are frequently used to conserve space yet provide structural support for flooring and the like. Ribbed slabs are also commonly referred to as pan joists, flange forms, or long forms, which are essentially T-beams arranged side by side with their flanges continuous. In this case, the ends of support ribs 24 tie into peripheral support ridge 23. When a normal load is applied to a beam, the upper portions of the beam are compressed (compression forces) and the lower portions of the beam are stretched (tension forces). This is commonly referred to as bending. These forces are resisted by the beam's mass and the size and shape of the cross section. A common example to illustrate this phenomenon is concrete, which is much weaker in tension.

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Columns, on the other hand are frequently utilized to provide structural support to ribbed structure. Columns, it will be noted, provide a higher level of structural support (assuming no lateral loading, columns are able to withstand significantly more forceful loads) than ribbed structural support (bending strength tends to be able to withstand less forceful loads). Thus, it will be noted that columns provide a significant amount of compressive strength to support a load. Ribbed structure, such as superior support surface 21, inferior support surface 22, and integrally formed support ribs 24 require a different amount of bending strength to support a load. Columns, however, occupy space intermediate the superior matter to be supported and the inferior matter upon which the columns are located. Support ribs 24 occupy only that space in immediate inferior adjacency to the superior matter to be supported and leave the space intermediate the inferior most portion of support ribs 24 and container bottom 101 unoccupied.

As has been noted, the frustoconically-shaped columns, of the '480 Patent appear ornamentally hollow. Presumably, the frustoconically-shaped columns of the '480 Patent were ornamentally designed to be hollow so as to otherwise receive and hold matter, perhaps the same matter supported by the so-called "superior surface" of the "plate" of the '480 Patent. The hollow, frustoconically-shaped columns, thus, presumably, serve a further function, namely, receiving and holding certain matter. Support ribs 24 receive no matter. The primary function of support ribs 24 is to provide SUPPORT, hence Applicants' use of the term, SUPPORT ribs 24 (emphasis added).

Applicants are cognizant of the compressive strength of frustoconically-shaped support columns versus the bending strength of support ribs (as integrally formed to inferior support surface 22) and the benefits and shortcomings of each. Applicants chose

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support ribs 24 with certain bending strength properties because they wished to avoid the shortcomings associated with the space-occupying characteristics of frustoconically-shaped support columns. It is contemplated, for example, that users of the Claim 29 invention, may wish to otherwise occupy the space intermediate the peripheral support rim 27 (as referenced in Figure Nos. 1, 3, 5, 6, and 7) and container bottom 101 (as illustrated in Figure Nos. 1 and 3) with some kind of lightweight matter or as storage for gardening tools and the like. Users of the invention as claimed in Claim No. 29 would find it relatively easy to utilize the space in this manner unhindered by support columns. Users of the invention as ornamentally shown in the '480 Patent may find it difficult to arrange matter located in the space intermediate the "inferior surface" of the "plate" and the bottom of the "pot".

Claim No. 29, in its entirety, has been reproduced below with certain portions thereof being highlighted for emphasis.

29. A container insert for creating a false bottom in an oversized planter container comprising a container bottom, a container rim, and a substantially uniformly sloped inner container surface, the inner container surface extending from the container bottom to the container rim, the inner container surface having a select container periphery intermediate the container bottom and the container rim, the container insert comprising:

a substantially planar superior support surface, a substantially planar inferior support surface, a peripheral support ridge, a plurality of support ribs, and

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a plurality of matter – receiving apertures, the peripheral support ridge comprising a sloped peripheral support surface and a peripheral support rim, the peripheral support surface being intermediate the superior support surface and the peripheral support rim, the peripheral support surface having a container – engaging depth, the support ribs being integrally formed to the inferior support surface and substantially equally spaced from one another, the matter – receiving apertures being spaced intermediate the support ribs and extending from the superior support surface to the inferior support surface, the peripheral support surface being in removably wedged engagement with the select container periphery, the container insert thus forming a false bottom in the oversized planter container at the select container periphery.

Throughout the specification of the present invention, it will be noted that sloped peripheral support surface 26 as referenced in Figure Nos. 1, 2, 3, 5, 7, 17(a), and 17(b) contacts or *engages* inner container surface 103 preferably at select container periphery 104. It will be seen from an inspection of Figure No. 5 of the '480 Patent and Exhibit A, that the so-called "sloped peripheral support surface" does not engage the inner surface of the "pot" or otherwise provide any direct contact support for the "plate". It will be further noted from a careful reading of Claim No. 29 that the peripheral support surface is in removably wedged engagement with the select container periphery (the point of contact being the container – engaging depth). The "container – engaging surfaces" of the '480 Patent, are presumably the inferior most portions of the so-called "support ribs" (i.e. support columns) and the radial terminus of the so-called "peripheral support rim".

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None of these structures comprise any appreciable container – engaging “depth.”

Moreover, the so-called “peripheral support surface” as identified in Exhibit A (and as further illustrated in Figure No. 5 of the ‘480 Patent) has no container – engaging structure whatsoever (there being a clear gap between the inner surface of the “pot” and the outer surface of the so-called “peripheral support surface”).

It is further noted that support ribs 24 do not engage inner container surface 103 of the present invention and thus Applicants are further confused as to how the so-called “support ribs” of the ‘480 Patent may be said to be anticipatory of support ribs 24 of the present invention. It is peripheral support surface 26 alone that makes contact with inner container surface 103. In the ‘480 Patent, it is the so-called “support ribs” that make “plate”-supporting contact with the inner container surface of the “pot”. Support ribs 24 provide additional bending strength to inferior support surface 22 (as well as superior support surface 21) so that inferior and superior support surfaces 22 and 21 may function to more effectively support loads placed thereupon.

According to the Federal Circuit Court, “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ at 313 (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), adopted, 149 USPQ 640 (Ct. Cl. 1966)). It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as further stated by the Federal Circuit Court, “[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann*

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Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)(emphasis added). Thus, even if the prior art reference includes all the elements that are claimed, if the arrangement of the claimed elements is different from the arrangement of the prior art elements, anticipation will not be present.

Applicants contend that the '480 Patent does not disclose support ribs 24 for various structural reasons and thus the hollow, frustoconically-shaped columns of the '480 Patent are not anticipatory of support ribs 24 (substantially uniformly rectangular in transverse cross-section as may be seen from a general inspection of Figure No. 19. Thus, each and every element of the claim under consideration is not disclosed in the '480 Patent. However, even if the support columns of the "plate" of the '480 Patent were somehow deemed to be anticipatory of support ribs 24, clearly, the so-called "peripheral support surface" as described in Exhibit A does not provide any direct structural contact support for the "plate" of the '480 Patent. Applicants therefore request clarification as to how the so-called "peripheral support surface" of the "plate" of the '480 patent is "[i]n removably wedged engagement with the select container periphery"... of the "pot" in the '480 Patent. This language appears in Claim No. 29 and thus Applicants maintain that the '480 Patent does not disclose ...each and every element of the claimed invention, arranged as in the claim.

The Federal Circuit Court has indicated that "[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." *Lindemann Maschinenfabrik*

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GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ at 485. If this issue were to be brought before a trier of fact, it is Applicants' opinion that the '480 Patent would not be construed as anticipatory of Claim No. 29 with the foregoing reasons providing partial grounds for the trier of fact. Since Claim Nos. 30 – 37 ultimately depend from independent Claim No. 29 and since Claim No. 29 is not anticipated by the '480 Patent, Applicants contend that Claim Nos. 30 – 37 are substantively patentable. It is noted that Claim No. 31 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regard as the invention. Applicants have amended Claim No. 31 in an effort to provide sufficient antecedent basis for the recited limitations (as currently appearing in the amended claim).

Since the U.S. Patent Examiner has not demonstrated all the required elements of the prima facie case with regard to the anticipation of Claim No. 29 by the '480 Patent, the U.S. Patent Examiner's opinion of anticipation is deficient and the Applicants are deserving of the allowance of this claim and all claims depending therefrom. In light of the foregoing, the U.S. Patent Examiner is kindly requested to reconsider the rejections and objections of record. It is believed that this amended patent application is now in immediate condition for allowance, and such action is kindly requested. If, after a review of this Amendment, issues remain which may be resolved by a telephone interview, the U.S. Patent Examiner is cordially invited to call the Applicants' undersigned attorney.

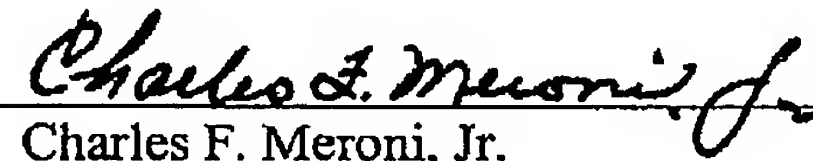
If attempts to reach the undersigned attorney are not successful, please be advised that Christopher J. Scott, Registration No. 48,647, may also be contacted with regard to this matter. Mr. Scott has been in regular communication with the undersigned regarding

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the Office Action and this Amendment. Further, Mr. Scott is listed under our Firm's
Customer Number with the United States Patent and Trademark Office, namely,
Customer Number 30114, and thus may be deemed a proper representative of Applicants.

Respectfully submitted,
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